

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Malik  
Serial No.: 09/750,138  
Filed: December 29, 2000

Confirmation No.: 6782  
Group Art Unit: 2143  
Examiner: Neurauter, George C.  
Docket No.: 190252-1720

**For: Method and Apparatus for Managing and Compacting Electronic Mail  
Messages**

**REPLY BRIEF RESPONSIVE TO EXAMINER'S ANSWER**

Mail Stop Appeal Brief - Patents  
Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

The Examiner's Answer mailed May 12, 2008 has been carefully considered.

In response thereto, please consider the following remarks.

It is not believed that additional extensions of time or fees are required to consider this Reply Brief. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to Deposit Account 20-0078.

**REMARKS**

In the Examiner's Answer, the Examiner has provided various responses to arguments contained in Applicant's Appeal Brief. Applicant addresses selected responses in the following. Applicant reasserts the arguments presented in the Appeal Brief, namely that the references of record fail to disclose ***determining whether the message has been previously compressed.***

The Examiner's Answer assumes that if a message does not meet predetermined criteria, it does not need to be compressed, and is an indication that the message has been previously compressed: "a file may either be uncompressed or compressed." See *Examiner's Answer*, page 13. However, this assumes that there is only one method of compressing a file – and if it has been compressed using this method, then it cannot be further compressed. Contrary to the Examiner's contention, there is more than one method to compress a file, and the file could be compressed by one compression method and then further compressed using a second compression method. Therefore, Applicant respectfully submits that the Examiner's contentions are incorrect and the rejections should be withdrawn.

Additionally, regarding claim 22, the Examiner's Answer alleges that "it is inherent within the reference that email servers receive and store messages for clients in their respective accounts or 'mailboxes' before the clients access their email account." See *Examiner's Answer*, page 8. However, Applicant respectfully disagrees. "Anticipation by inherency requires that 1) the missing descriptive matter be 'necessarily present' in the prior art reference ..." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264 (Fed. Cir. 1991). Applicant respectfully submits that the messages could be stored in a general email storage folder and the messages could be pulled from the general mailbox upon a poll by the client. Therefore, it is

not inherent to the disclosure of *Shaffer* for email servers to receive and store messages for clients in their respective accounts or 'mailboxes' before the clients access their email accounts.

**CONCLUSION**

Based upon the foregoing discussion, Applicants respectfully request that the Examiner's final rejection of claims 1-3, 6-8, 15, and 21-45 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

Respectfully submitted,

/BAB/  
**Benjamin A. Balser, Reg. No. 58,169**

**THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1500  
600 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500